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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,145	09/09/2003	David Alexander	IMMR023/04US	1899

7590

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EXAMINER
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HARRIS, CHANDA L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/657,145	ALEXANDER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chanda L. Harris	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/5/04</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Status of Claims***

In response to the Amendment filed 5/13/05, Claims 12-20 are pending. Claims 1-11 and 21-33 are cancelled.

### ***Allowable Subject Matter***

The indicated allowability of claims 12-17 and 19-20 is withdrawn in view of the newly discovered reference(s) to Wang et al. (US 5,855,583) and Sullivan et al. (US 5,746,753). Rejections based on the newly cited reference(s) follow.

### ***Information Disclosure Statement***

The information disclosure statement filed 9/15/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. This refers to the documents that have been lined through on the information disclosure statement.

### ***Specification***

1. The disclosure is objected to because of the following informalities: The continuity data on the first page of the specification needs to be updated with the current status of the parent application.

Appropriate correction is required.

2. The use of the trademark IMMERSION PROBE has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Claim 12 recites the limitation "the coupling mechanism" in line 4. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 12, 16-17, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al. (US 5,855,583).**

1. [Claim 12]: Regarding Claim 12, Wang discloses a capture mechanism configured to engage a peripheral device (i.e., object). See Col.11: 58-61. Wang discloses the capture mechanism having a grasping member (i.e., finger, Col.12: 21-27) and an actuator (i.e., controller, Col.6: 52-56). Wang discloses the actuator being configured to actuate the grasping member in response to a movement of the peripheral device. See Col.6: 41-46. Wang discloses a coupling mechanism being configured to move in response to the movement of the peripheral device when the peripheral device is engaged by the capture mechanism. See Col.5: 64-66. Wang discloses a sensing assembly (i.e., pressure sensors) configured to detect a manipulation of the peripheral

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device while the peripheral device is engaged by the capture mechanism. See Col.11: 58-61.

2. [Claim 16]: Regarding Claim 16, Wang discloses wherein the capture mechanism is disclosed within the sensing assembly. See Col.11: 58-61.

3. [Claim 17]: Regarding Claim 17, Wang discloses wherein the capture mechanism further includes a plurality of jaws (i.e., fingers) to surround and engage the peripheral device. See Col.12: 21-26.

4. [Claim 19]: Regarding Claim 19, Wang discloses an automatic capture-and-release mechanism configured to automatically actuate the plurality of jaws to engage the peripheral device. See Col.6: 41-46.

5. [Claim 20]: Regarding Claim 20, Wang discloses wherein the capture mechanism has a plurality of jaws, the plurality of jaws of the capture mechanism are actuated by a force applied by a lever (i.e., handle) associated with a movement of the peripheral device. See Col.6: 41-46 and Col.12: 21-26.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Sullivan et al. (US 5,746,753).**

1. [Claim 13]: Regarding Claim 13, Wang does not disclose expressly wherein the grasping member has a tubular shape (i.e., tubular member). However, Sullivan teaches such in Col.4: 67-Col.5: 5. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate wherein the grasping member has a tubular shape into the method and apparatus of Wang, in light of the teaching of Sullivan, in order to facilitate suturing of a patient's tissue.
2. [Claim 14]: Regarding Claim 14, Wang does not disclose expressly a spring (i.e., spring member) configured to elongate and compress the tubular grasping member in response to movement of the peripheral device such that the cross-sectional dimension of the tubular grasping member is adjusted. However, Sullivan teaches such in Col.5: 38-53. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate a spring into the method and apparatus of Wang, in light of the teaching of Sullivan, in order to provide a lost motion transfer assembly.


***Allowable Subject Matter***

Claim 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 571-272-4448. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Chanda L. Harris  
Primary Examiner  
Art Unit 3714